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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,045	02/21/2002	Jean-Louis Gerstenmayer	025219-390	9335

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EXAMINER

HANNAHER, CONSTANTINE

ART UNIT	PAPER NUMBER
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2878

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,045

Applicant(s)

GERSTENMAYER ET AL.

Examiner

Constantine Hannaher

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 20-22 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-18 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

## **DETAILED ACTION**

### **National Stage Application**

1. The Examiner acknowledges consideration of the International Preliminary Examination Report in International Application PCT/FR00/02634. MPEP § 1893.03(e).

### **Information Disclosure Statement**

2. As set forth in MPEP § 609:

37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

3. The references cited in the Search Report for PCT/FR00/02634 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

### **Oath/Declaration**

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It is not plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent, as required under 37 CFR 1.52(a)(1)(iv).

When applicant states that the post office address is the “same” as residence applicant’s representative should keep in mind that a “residence” is a city and state or foreign country. The superfluous information given for residence is accepted as constituting a mailing address. The Office has *not* been able to discern the city and state or foreign country of residence from the information supplied. See the requirements of 37 CFR 1.63(c)(1) as amended effective November 7, 2000.

### **Specification**

5. Because acceptable units generally have internationally recognized symbols and names, it is not permissible to use abbreviations for their unit symbols or names, such as sec (for either s or second), sq. mm (for either mm<sup>2</sup> or square millimeter), cc (for either cm<sup>3</sup> or cubic centimeter), mins (for either min or minutes), hrs (for either h or hours), lit (for either L or liter), amps (for either A or amperes), AMU (for either u or unified atomic mass unit), or mps (for either m/s or meter per second).

Note the use of the “sec” in claim 3 and page 4, line 20, and elsewhere; note the use of the “gm” in claim 18 and page 5, line 6, and elsewhere. The proper use of the metric system is a requirement of PCT Rule 10.1(a).

### **Double Patenting**

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214

USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 15, 3, 4, 16, 5, 17, 6, 18, 7, 9, 10, 11, 13, 14, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-16, 20, and 22 of copending Application No. 09/926,328 in view of Schropp *et al.* (EP0917208).

With respect to independent claim 1, this claim differs from claim 12 of the copending application in the identification of the layer of semiconducting material as that of a composite with host matrix and guest particles. A semiconducting composite material comprising a host matrix made of a polymer and guest particles of the semiconductor type dispersed throughout the host matrix is known, as shown by Schropp *et al.* In view of the reduced cost of a solid state composition creating an interpenetrating conducting material (semiconducting in view of the listing of known II-VI semiconductors) in a nanoporous network as described by Schropp *et al.*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claim to a detector of incident ionizing radiation in the copending application to specify that the layers of semiconducting material were a composite of host matrix and guest particles.

With respect to dependent claim 2, the polymer disclosed by Schropp *et al.* is of at least one of the recited group (and thus anticipates that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 15 and 3, the polymer disclosed by Schropp *et al.* has the recited feature (because of the identity of the material and thus anticipates that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claim 4, the polymer disclosed by Schropp *et al.* is one of the recited group (and thus anticipates that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 16 and 5, the semiconductor particles disclosed by Schropp *et al.* have at least one of the recited features (and thus anticipate that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 17 and 6, the semiconductor particles disclosed by Schropp *et al.* are of at least one of the recited group (and thus anticipate that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 18 and 7, the semiconductor particles disclosed by Schropp *et al.* have the recited properties (and thus anticipate that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claim 9, this claim does not differ from claim 13 of the copending application.

With respect to dependent claim 10, this claim does not differ from claim 14 of the copending application.

With respect to dependent claim 11, this claim does not differ from claim 15 of the copending application.

With respect to dependent claim 13, this claim does not differ from claim 20 of the copending application.

With respect to dependent claim 14, this claim does not differ from claim 22 of the copending application.

With respect to dependent claim 12, this claim does not differ from claim 16 of the copending application.

This is a provisional obviousness-type double patenting rejection.

#### **Response to Submission(s)**

8. The amendment filed February 21, 2002 has been entered.

#### **Allowable Subject Matter**

9. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 8 and 20-22 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: although it is presumed that coating to prevent agglomeration of guest particles in a host matrix is a known procedure, Schropp *et al.* does not suggest the step.

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (703) 308-4850. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (703) 308-4852. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

ch

*Constantine Hannaher*  
Constantine Hannaher  
Primary Examiner